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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/317,303	05/24/1999	BRUCE A. DONOHO	DONO-7	8945
34284	7590	10/20/2005	EXAMINER	
ROBERT D. FISH RUTAN & TUCKER LLP 611 ANTON BLVD 14TH FLOOR COSTA MESA, CA 92626-1931			PALO, FRANCIS T	
			ART UNIT	PAPER NUMBER
			3644	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/317,303

Applicant(s)

DONOHO, BRUCE A.

Examiner

Francis T. Palo

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 and 20-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-16 and 20-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to because **the depictions of Figures 3 and 4 are not consistent with the depiction of Figure-1**; specifically, the lateral positions of the prongs depicted in Figure-3 on each side of the rail (15) conflict with the positions as depicted in Figure-1 (the left-hand basal edge of prongs 24 and 26 [for instance] should be in line with each other, as each extends outward at an equal distance from the rail as depicted in Figure-1; regarding Figure-4, should the glue trough (17) and the rail(15) be centered as depicted in Figure-3?

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

Therefore, **the apparatus as claimed in independent claim-10** must be shown or the feature(s) canceled from the claim(s); specifically, the claim recites a rail having laterally extending prongs (**no superior prongs** to the laterally extending prongs).

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 10, 11, 20, 21, 24-29 and 31-33 are objected to because of the following informalities: Appropriate correction is required.

Regarding independent claim-10:

On line-5: "a cross-shaped cross section" is recited, while in Figure-1 the prongs are depicted as having a cross-shaped cross section and circular cross section.

The claim language should be amended to reflect the depiction and written description of the prongs in cross-section, so as not to inadvertently mislead the reader that the prongs are entirely cross-shaped in cross section, as that is not what is taught by the instant invention; it is suggested that in line-5, "have" be changed to --comprise--, or other equivalent language.

On line-7: "alternating" should be changed to --alternate--.

On line-8: "a" should be changed to --an--, as a underlying surface is not being claimed as part of the invention, and the use of "an" reads better than "a" in this instance (respectfully).

Art Unit: 3644

Regarding **claim-11**:

The language of lines 3-5, following “spaced positions” is confusing, specifically, the two instances of “at one of”.

The Examiner suggests rewording the language following “spaced positions” to;
--at an angle greater than the opposite member of each pair which extends at
substantially the same position along the opposing side of the rail.--.

Regarding **claim-20**:

See the discussion above regarding claim-10 and the prong cross sections;
Specifically, in the instant claim, “has” should be changed to --comprise--, or an
equivalent.

Regarding **claim-21**:

“comprising” should be changed to --comprises--; furthermore, claims 20 and 21 are
redundant and one should be deleted.

Regarding **claim-24**:

In the second line of the claim; “of the rail has” should be changed to --and--.

Regarding **claim-25**:

“its upper surface” should be changed to --the rail--, or alternatively, “along its upper
surface” should be changed to --coextensive with the rail--.

Art Unit: 3644

Regarding **claim-26**:

In the claim following the comma (,) the text should be changed to, --further comprising a plurality of prongs extending from the rail superior to the lateral prongs.

Regarding **claim-27**:

In the second line, "the" should be changed to --opposing--.

Regarding **claims 27-29**:

There is no antecedent basis for "the superiorly extending prongs" in the claims, as 'superiorly extending prongs' are not positively recited for in the parent claim-10.

Regarding **independent claim-31**:

On line-5; "angles, and" should be changed to --angles, on each side of the rail with respect to an underlying surface, and--.

On line-9; "have" should be changed to --comprise--(see the discussions above regarding claims 10 and 20.

Regarding **claim-32**:

There is no antecedent basis for "the laterally extending flanges" in the claim, as 'laterally extending flanges have not been positively recited for previously (in the parent claim).

Regarding **claim-33**:

The order of the trough and notches cited should be reversed, so as not to confuse the reader with the notches being integral to the bottom surface.

Response to Arguments

Applicant's arguments filed 7/25/05 have been fully considered but they are not persuasive.

Applicant submits an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions, but is not specific in discussing the reference applied against the claims, nor explaining how the claims avoid the references or distinguish from them.

The Examiner acknowledges amendment of the independent claims 10 and 31 by incorporation of claim-19 (now canceled), and submits that the cross-section is different from that shown in Figure-12 of Shaw, and further submits the rejections of claims 13 and 18 are obviated by the amendments to the claims; the Examiner is unclear if the Applicant is referring to the amendments to the independent claims and or dependent claims 13 and 18, the latter only addressing objections raised in the previous office action.

The Applicant is reminded that the written description of the instant invention is silent as to any criticality to the cross-section of the prongs as cited in the cancelled claim-19, and now recited in the independent claims, and merely submitting that the cross-section of the prongs is different from the teaching reference is not a convincing argument.

Furthermore, in the absence of any stated problems solved by or any stated advantage obtained by having a cross-section as claimed in the instant invention, the Examiner maintains that having a cross-section as cited, is merely an alternate equivalent prong means performing the same intended function of any prong means, and further, any amendment to the written description discussing a criticality of the cross-section will be considered as new matter and not considered proper in this application, whereas such a discussion would be proper in a continuation-in-part application wherein the criticality of the cross-section and criticality of the prongs alternating configuration on each side of the rail could be disclosed and expanded upon.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-18, and 20-34 are rejected under 35 U.S.C. 102(b),
as anticipated by or, in the alternative, under 35 U.S.C. 103(a),
as obvious over Richardson (GB 2344269) filed 3/12/1998.

Regarding amended **independent claim-10**:

Richardson teaches a bird repellant device in the Abstract, having;
a base element (read as a rail, as cited) of plastic material molded (read as
encompassing "injection molding", as cited) integrally with a plurality of plastics material
prongs extending at at least four different angles to the base element, and the plurality
of prongs may extend from the base element as a sequence of laterally staggered first
and second pairs of mutually diverging prongs located in planes that are spaced apart in
a direction transverse to the planes.

Richardson is silent as to the cross-section as cited.

In the absence of any stated problems solved by or any stated advantage obtained by
having a cross-section as claimed in the instant invention, it would have been obvious to
one of ordinary skill in the art at the time the invention was made, to have modified the
prongs of Richardson to have a cross-section as claimed, as further such modification is
merely an alternate equivalent prong configuration performing the same intended
function of deterring birds from the underlying surface.

Art Unit: 3644

Regarding amended independent **claim-31**:

The discussion above regarding claim-10 is relied upon.

The independent claims cite a product-by-process limitation (injection molded piece), which is not given patentability weight, however, Richardson teaches an integrally molded plastic construction (abstract) wherein a rail, a plurality of laterally extending prongs and a plurality of superiorly extending prongs are readily apparent from the figures.

Richardson further depicts laterally extending prongs alternating between relatively higher and lower angles, wherein prongs (11) and (12) are readable thereon as well as prongs (12) and (14), and prongs (11) and (12) are arranged in pairs as cited.

Richardson further depicts the superiorly extending prongs (13) alternating with the pairs of prongs (11) and (12) as cited.

Finally, the prong cross-section as claimed is discussed above in the preceding claim rejection.

Regarding dependent **claims 11-18, 20-30 and 32-34**:

Since the dependent claims have not been traversed in the applicant's response to the previous office action, the rejections are maintained as previously presented and not repeated herein this office action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 571-272-6907. The examiner can normally be reached on M-Tu.,Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Francis T. Palo

Francis T. Palo
Examiner
Art Unit 3644